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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,802	05/06/2002	Graham Paul Luscombe	2544/111	7249

2101 7590 10/24/2003  
BROMBERG & SUNSTEIN LLP  
125 SUMMER STREET  
BOSTON, MA 02110-1618

EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 10/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/019,802

Applicant(s)

LUSCOMBE ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-14, 16-18 and 20-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-14 and 16 is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 20-32 is/are rejected.
- 7) ☒ Claim(s) 33-45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The objection to the specification, outlined in the previous Office Action (Paper No. 7), has been overcome by applicant's amendment (Paper No. 8). The amendment clarifies the text as appropriate.

With respect to applicant's statement that a new abstract on a separate page was attached to the amendment. The examiner states for the record that no such abstract is of record in the application and respectfully requests that applicant include an acceptable abstract in applicant's next communication with the Office.

### ***Claim Objections Withdrawn***

The objection to claims 1 and 11-14, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment corrects and/or clarifies the claim language as appropriate.

### ***112 Rejections Withdrawn***

The rejection of claims 1-18 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. With specific regard to claims 1, 11, 16 and 17, the amendment clarifies the claim language as appropriate. With respect to the remaining claims, the rejection is moot.

***102 Rejections Withdrawn***

The rejection of claims 1-15 under 35 USC 102(b), outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment cancels claims 1 and 15. With respect to the remaining claims, the amendment rewrites the claims as method claims dependent from allowable claim 16.

***Withdraw of Allowability***

The allowability of claims 17 and 18, as indicated in the previous Office Action, was inadvertently incorrect. The examiner regrets the error. A new rejection follows.

***Claim Rejections - 35 USC § 102, NEW***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17, 18 and 20-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 94/26704. The reference teaches applicant's method of using the instant compounds for the treatment of obesity (page 10 line 23). The examiner considers a method of 'reducing cravings for food' inherent to the treatment of obesity.

***Allowable Subject Matter***

Claims 2-14 and 16 are allowed. Claims 33-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening

Art Unit: 1621

claims. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art remains the prior art of record, WO 94/26704, which teaches a method using the instant compounds in the treatment of depression, anxiety, Parkinson's disease, obesity, cognitive disorders, seizures, neurological disorders (epilepsy) and as neuroprotective agents (stroke) (page 10 line 20). The reference neither teaches nor suggests, however, the use of the compounds in a method to treat addiction. Nor would it have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the prior art in order to arrive at those of the instant invention. There is no motivation to do so.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 703-305-7129. The examiner can normally be reached on 8:30-5:00.

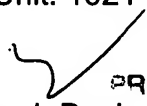
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

Application/Control Number: 10/019,802

Page 5

Art Unit: 1621

 **BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
October 21, 2003